

REMARKS/ARGUMENTS

Claims 1-22 are pending in this application wherein claims 1, 11 and 17 are in independent format. In this Office action response, claims 1, 11 and 17 have been amended and new dependent claims 23 and 24 have been added. In view of the arguments and claim amendments, the Applicant considers the grounds of rejection to be moot.

Rejection Under 35 U.S.C. 102(b)

The Examiner rejected claims 1-4 under 35 U.S.C. 102(b) as allegedly being anticipated by *Clemons* (U.S. Patent No. 5,961,293) (hereinafter the “*Clemons*” reference).

A prima facie case of anticipation is established when the Examiner provides a single reference that teaches or enables each of the claimed elements (arranged as in the claim) expressly or inherently as interpreted by one of ordinary skill in the art. In the present application, Applicants submit that a prima facie case of anticipation has not been established. Applicants submit that claim 1, as amended, and its respective dependent claims, particularly point out and distinctly claim their invention, and that their invention is neither taught nor suggested by the cited reference.

Claim 1 has been amended to include the limitations that the response means variably controls the higher outlet fuel pressure by which the response means variably controls the fuel through the fuel inlet. Claims 11 and 17 have also been amended to include the limitation that the processor variably controls the outlet fuel pressure.

In contrast, the *Clemons* reference teaches an in-tank fuel pump assembly to supply fuel at a constant pressure to the engine. (*See:* Column 1, lines 19-20; Column 10, lines 12-13). The Applicant respectfully submits that the *Clemons* reference does not teach the limitations of variably controlling the higher outlet fuel pressure by variably controlling the fuel through the fuel inlet, and as such a prima facie case of anticipation is not established.

Dependent claims, by their nature, include all of the limitations of the parent independent claim and any intervening claims from which they depend. Claims 2-10 depend directly or indirectly from independent claim 1 and accordingly, are believed

allowable under 35 U.S.C. § 102 (b) over the *Clemons* reference, for at least the same reasons as independent claim 1.

Rejection Under 35 U.S.C. 103(a)

The Examiner rejected claims 4-22 under 35 U.S.C. 103(a) as allegedly being unpatentable over *Clemons* in view of *Kenney* et al. (U.S. Patent No. 6,652,249) (the “*Kenney*” reference).

Applicants note that, under M.P.E.P. § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation for success. Finally, the prior art reference (or references when combined) must teach or suggest all the claimed limitations. Applicants further submit that it is improper to combine the references where the references teach away from their combination. (*See*: M.P.E.P. § 2145 X.D.2).

The present invention teaches a non-constant pressure of fuel delivered to the engine; i.e., a variable outlet fuel pressure. The processor varies the outlet fuel pressure between higher and lower levels depending on an input from the controller. (*See*: Specification p. 3, lines 16-20). Controlling the speed of the pump motor, sensing the output pressure and comparing the desired pressure against the measured pressure achieve the desired outlet pressure. *Id.* Accordingly, the outlet pressure of the fuel pump of the present invention can be controlled for more than two outlet pressure values. *Id.*

As noted, the *Clemons* reference teaches supplying fuel at a constant pressure. This constant pressure limits the fuel performance of the fuel pump assembly and the efficiency of the fuel delivery system. (*See*: Specification p. 3, lines 2-5). The reference may not be considered to teach the invention and therefore fail to support an obviousness rejection when the objective of the reference reinforces such an interpretation. (*See*: *WMS Gaming Inc. v. International Game Technology*, 184 F.3d 1339 (Fed. Cir. 1999)).

The *Kenney* reference teaches a brushless DC wet motor fuel pump. This fuel pump balances the pressure on either side of the rotor and vanes. (*See*: Column 5, lines

65-67). The *Kenney* reference does not teach variably controlling the higher outlet fuel pressure and variably controlling the fuel through the fuel inlet.

Applicants respectfully submits that there is not a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Additionally, the references, alone or in combination, do not teach or suggest all the claimed limitations, and as such a *prima facie* case of obviousness is not established.

Dependent claims, by their nature, include all of the limitations of the parent independent claims and any intervening claims from which they depend. Claims 5-10, 12-16 and 18-24 depend directly or indirectly from independent claims 1, 9 and 17, and accordingly, are believed allowable, for at least the same previous reasons as independent claims 1, 9 and 17.

For at least the foregoing reasons, claims 1-24 are believed to be in condition for allowance. Issuance of a Notice of Allowance with respect to the claims is thus respectfully requested. If for any reason the Examiner is unable to allow the application on the next Office Action and feels that an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to contact the undersigned attorney for the purpose of arranging such an interview.

Respectfully submitted.

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